

REMARKS

Claims 1-32 were pending in the application. The Examiner has required restriction of the pending claims under 35 U.S.C. § 121 to one of the following groups:

- I. Claims 1-12 and 15, drawn to a compound of formula (I), classified in class 548, numerous subclasses;
- II. Claims 13 and 14, drawn to an enantiomerically pure compound of formula (I), classified in class 548, numerous subclasses;
- III. Claims 16-19, drawn to a pharmaceutical composition, classified in class 514, numerous subclasses;
- IV. Claims 20-22, drawn to a method of inhibiting/modulating PDE4, classified in class 514, numerous subclasses;
- V. Claims 23-32, drawn to a method for the, classified in class 514, numerous subclasses.

The Examiner contends that each of Groups I to V are distinct from the other Groups.

In order to be fully responsive, Applicants hereby provisionally elect to prosecute the invention of Group I, claims 1-12 and 15.

With respect to a species election, Applicants hereby provisionally elect the specific compound 36 on page 29 of the patent application publication No. US 2004/02004448, *i.e.*, N-{2-[1-(4-Difluoromethoxy-3-ethoxy-phenyl)-2-methanesulfonyl-ethyl]-1,3-dioxo-2,3-dihydro-1-H-isoindol-4-yl}-acetamide, which is synthesized in section 5.36 on page 29 of the application publication and specifically claimed in claim 15.

The elected species read on claims 1, 3, 11, 12 and 15 of Group I.

With respect to the division of the application into five groups of claims, Applicants respectfully traverse the restriction requirement. Applicants submit that to search and examine the claims of Groups I and II together would not be a serious burden, as both Groups of claims are drawn to the compounds having identical empirical formula and are identified by the Examiner as being in the same class. The M.P.E.P. § 803 (Seventh Edition, Rev. 1, July 2000) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Similarly, Applicants submit that to search and examine the compound and method-of-treatment claims together would not be a serious burden; that is the claims of Groups I , II and V together.

Applicants respectfully request that the restriction requirement be revised to place Groups I, II, and V together, directed to products and methods of using products of Formula I, classified in classes 514 and 548.

Attorneys for Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Should the species restriction be maintained, Applicants, upon the allowance of a generic claim, will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim pursuant to 37 C.F.R. § 1.141.

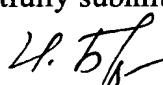
CONCLUSION

Examination on the merits of the elected subject matter is respectfully requested. Applicants respectfully request that the present remarks be made of record in the file history of the present application. The Examiner is invited to contact the undersigned with any questions concerning the application.

The Commissioner is hereby authorized to charge any fee(s) deemed due, including extension of time fees, to Jones Day Deposit Account No. 503013.

Respectfully submitted,

Date: June 27, 2006


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